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Filed: June 29, 2000
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REMARKS

Claims 52 and 53 are pending in the subject application. By this Amendment, applicants have amended claim 52. The amendments to claim 52 involve a formatting change to delete the word "molecule", and other changes which are fully supported in the specification as filed at, *inter alia*, page 26, lines 14-32; page 27, lines 31-37; page 22, lines 25-29; page 23, lines 21-26; and page 17, lines 20-27. Thus, these amendments do not raise any issue of new matter. Accordingly, applicants respectfully request that the Examiner enter this Amendment. Upon entry of this Amendment, claims 52 and 53, as amended, will be pending and under examination.

The Invention

The invention claimed in the subject application provides an isolated peptide (i) encoded by a nucleic acid of at least 30 nucleotides in length having a sequence which constitutes a portion of the sequence set forth in SEQ ID NO:14, and (ii) which binds to an antibody in a binding reaction that is determinative of a herpesvirus associated with Kaposi's sarcoma. This herpesvirus is (a) present in and recoverable from the HBL-6 cell line (ATCC Accession No. CRL 11762) or (b) has a genome having substantial sequence identity with the sequence set forth in SEQ ID NO:1. The invention also provides a composition comprising the instant isolated peptide and a carrier.

Continued Examination Under 37 C.F.R. §1.114

The Examiner stated that a request for continued examination under 37 C.F.R. §1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. The Examiner also stated

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that since this application is eligible for continued examination under 37 C.F.R. §1.114 and the fee set forth in 37 C.F.R. §1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 C.F.R. §1.114 and prosecution in this application has been reopened.

In response, and to correct the record, applicants note that no appeal was filed in the subject application. Applicants note that instead, a Notice of Appeal was filed in this case on March 16, 2005 (received March 21, 2005 by the Patent Office), and a request for continued examination was filed on July 19, 2005 in lieu of an Appeal Brief.

Priority Claim

The Examiner acknowledged applicants' claim for domestic priority to U.S. Serial No. 08/343,101 (now U.S. Patent No. 5,830,759) under 35 U.S.C. §120. The Examiner stated, however, that the application upon which priority is claimed fails to provide adequate support under 35 U.S.C. §112 for claims 52-53 of the subject application. The Examiner further stated, specifically, that SEQ ID NO:14 is not disclosed in the 08/343,101 priority application. The Examiner also stated that, as such, priority is granted only to April 4, 1995 (the filing date of U.S. Application No. 08/420,235, now U.S. Patent No. 5,801,042), wherein instant SEQ ID NO:14 is disclosed in its entirety.

In response, applicants acknowledge the Examiner's position without conceding its correctness.

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Rejections Under 35 U.S.C. §102(b)

The Examiner rejected claim 52 under 35 U.S.C. §102(b) as allegedly anticipated by Josephs et al. (J. Virol. 65: 5597-5604, 1991, citing the entire document; henceforth "Josephs"). The Examiner stated that claim 52 is construed as directed to a polypeptide. The Examiner also stated that: the polypeptide must first be encoded by a nucleic acid; this nucleic acid must be at least 30 nucleotides in length; and the nucleic acid must comprise a portion of SEQ ID NO:14. The Examiner asserted that since SEQ ID NO:14 is a nucleic acid sequence that comprises adenine, any nucleic acid that is at least 30 nucleotides long and has at least one adenine residue meets the limitations of the nucleic acid. The Examiner also noted that the polypeptide must also be recognized by an antibody that recognizes a protein that is encoded by a herpesvirus associated with Kaposi's sarcoma (KS). The Examiner further stated that Herpesvirus-6 (HSV-6) is known to be associated with KS and contended that, therefore, a nucleotide sequence that is at least 30 nucleotides long and has at least one adenine, and which encodes an HSV-6 polypeptide, meets the limitations of the claim. The Examiner asserted that claim 53 merely reads on a composition comprising the polypeptide of claim 52, along with a carrier (which can be water, or virtually any other material).

The Examiner also stated that Josephs teaches the identification of Glycoprotein H protein from HSV-6 (citing, for example, the Abstract and Figure 2). The Examiner further stated that this protein is 694 amino acids in length (encoded by a nucleotide sequence of 2094 nucleotides in length; citing, for example, page 5600, right column), and thus represents a protein encoded by a nucleotide sequence of over 30 nucleotides in length that contains at least one adenine residue, wherein the encoded protein is recognized by an antibody that detects proteins encoded by a

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herpesvirus associated with KS. The Examiner concluded that, as such, Josephs anticipates the invention as claimed.

In response, applicants respectfully traverse this rejection. Without conceding the correctness of the Examiner's position, applicants note that independent claim 52, as amended, specifies that the herpesvirus associated with Kaposi's sarcoma is (a) present in and recoverable from the HBL-6 cell line (ATCC Accession No. CRL 11762) or (b) has a genome having substantial sequence identity with the sequence set forth in SEQ ID NO:1. Applicants note that Josephs does not disclose a herpesvirus which is either present in and recoverable from the HBL-6 cell line or has a genome having substantial sequence identity with the sequence set forth in SEQ ID NO:1. Accordingly, applicants maintain that Josephs does not anticipate claim 52, as amended.

Applicants note that claim 53 depends from claim 52 and therefore necessarily possesses all the elements of claim 52. Applicants maintain that since Josephs does not anticipate claim 52, this reference also does not anticipate claim 53. Accordingly, applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection.

The Examiner also rejected claims 52 and 53 under 35 U.S.C. §102(b) as allegedly anticipated by Liu et al. (Virology 197: 12-22, 1993, citing the entire document; henceforth "Liu"). The Examiner stated that Liu teaches the production of HSV-6 Glycoprotein H, and its interaction with an antibody (citing, for example, the Abstract and Figure 1). The Examiner asserted that because HSV-6 Glycoprotein H represents a protein encoded by a nucleotide sequence of over 30 nucleotides in length containing at least one adenine residue, wherein the encoded protein is recognized by an antibody that detects proteins encoded by a

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herpesvirus associated with KS, Liu anticipates both the claimed protein and a composition comprising this protein.

In response, applicants respectfully traverse this rejection. Without conceding the correctness of the Examiner's position, applicants note again that independent claim 52, as amended, specifies that the herpesvirus associated with Kaposi's sarcoma is (a) present in and recoverable from the HBL-6 cell line (ATCC Accession No. CRL 11762) or (b) has a genome having substantial sequence identity with the sequence set forth in SEQ ID NO:1. Applicants note that Liu does not disclose a herpesvirus which is either present in and recoverable from the HBL-6 cell line or has a genome having substantial sequence identity with the sequence set forth in SEQ ID NO:1. Accordingly, applicants maintain that Liu does not anticipate claim 52, as amended.

Further, applicants maintain that since Liu does not anticipate claim 52, this reference also does not anticipate claims 53 which depends directly from claim 52 and therefore necessarily possesses all the elements of claim 52. Accordingly, applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection.

Conclusion

In view of the preceding remarks, applicants maintain that the claims 52 and 53, as amended herein, are in condition for allowance. Applicants therefore respectfully request that the Examiner reconsider and withdraw the grounds of rejections set forth in the August 24, 2005 Office Action, and earnestly solicit allowance of the claims pending in the subject application.

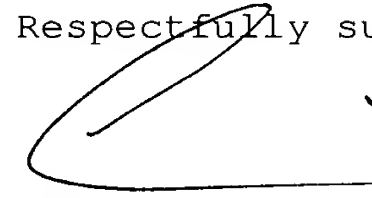
If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned

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attorneys invite the Examiner to telephone them at the number provided below.

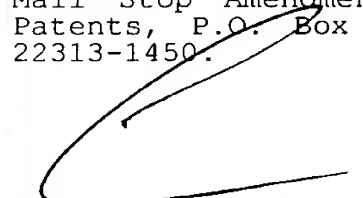
No fee is deemed necessary in connection with the filing of this Amendment. However, if any fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to:
Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450.



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11/23/01
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